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10/091,248	03/05/2002	Maria Rene Ebling	YOR920010659US1	6737

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EXAMINER	
AU, SCOTT D	

ART UNIT	PAPER NUMBER
2635	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/091,248	Applicant(s) EBLING ET AL.	
	Examiner Scott Au	Art Unit 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9,10,13-16 and 20-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9,10,13-16 and 20-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This communication is in response to applicant's response to an Amendment A, which is filed August 13, 2004.

An amendment A to the claims 1-27 have been entered and made of record in the Application of Ebling et al. for an "Method and apparatus for providing dynamic user alert" filed March 5, 2002.

Claims 1-7, 9-10,13-16 and 20-27 are pending.

Claims 8, 11 and 17-19 are cancelled.

Response to Arguments

Applicant's amendments and argument to the rejected claims are insufficient to distinguish the claimed invention from the cited prior arts to overcome the rejection of said claims under 35 U.S.C 103(a) as discussed below. Applicant's amendment and argument with respected to the pending claims 7-9, 18,19, 22 and 25, have been fully considered but they are not persuasive for at least the following reasons.

On page 10, paragraphs 2-3, Applicant's argument with respect to the invention of Motohashi that no where does Motohashi teaches or suggests "making an environment-appropriate alert mode determination based on context provided by an environment that the user is in", is persuasive. Therefore, the amended claims are further in view of Theimer et al..

On page 10, fourth paragraph, Applicant's argument with respect to the invention of Theimer et al. that Theimer fail to teach or suggest "making an environment-appropriate determination based on context provided by an environment that the user is in", is not persuasive.

Theimer et al. disclose a system in which the delivery of electronic messages to a particular user or users may be selective, depending upon the context or state of the user or users. Furthermore, appropriate computing devices for particular actions, such as delivery of electronic messages, are selected based on the environment in proximity to the user in relation to the properties of the message. The system may have knowledge not only of users, machines, and computing devices, but of the context and environment that the users and devices are operating in. The system may know, for example, the physical location of a user, what computing devices are available at that location, what other users may be in close proximity to the user. The system may further provide processing continuity over a range of locations. For particular operations, the system may be able to discern predefined control variables, and may be sensitive to the context of certain actions.

On page 11, second paragraph, Applicant's argument with respect to the invention of Motohashi in view of Theimer is improper to combine, is not persuasive.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make

the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Motohashi discloses the radio paging receiver is included as one of radio terminals together with a transmitting station 11 in a paging system and is for receiving a radio signal transmitted from the transmitting station 11. The radio paging receiver has a function which is called a call condition indicating function according to the condition indicating codes (col. 2 lines 36-67).

In the same field of communication system, Theimer et al. disclose a system in which the delivery of electronic messages to a particular user or users may be selective, depending upon the context or state of the user or users. Furthermore, appropriate computing devices for particular actions, such as delivery of electronic messages, are selected based on the environment in proximity to the user in relation to the properties of the message. The system may have knowledge not only of users, machines, and computing devices, but of the context and environment that the users and devices are operating in. The system may know, for example, the physical location of a user, what computing devices are available at that location, what other users may be in close proximity to the user. The system may further provide processing continuity over a

range of locations. For particular operations, the system may be able to discern predefined control variables, and may be sensitive to the context of certain actions.

One of ordinary skill in the art understands that making an environment-appropriate determination based on context provided by an environment that the user is in of Theimer et al. is desirable in the paging system of Motohashi because Motohashi suggest different alert indications when paging device receives incoming signal and Theimer et al. suggest delivering the messages are selected based up on the environmental sensitive context of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to include delivering the messages are selected based up on the environmental sensitive context of the user of Theimer et al. in the paging system of Motohashi with the motivation for doing so would allow the user with more privacy of receiving the message.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-16 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Theimer et al. (US# 5,493,692).

Referring to claim 13, Theimer et al. disclose a method of sending a message and providing a dynamic alert indication therewith, the method comprising the steps of:

identifying a recipient of the message (col. 27 lines 60-62);

accessing a database to determine the recipient's alert indication preferences (col. 14 lines 43-48);

determining an environment-appropriate method of alert indication based on the recipient's alert indication preferences and context provided by the environment that the user is in (col. 4 lines 27-42 and col. 14 line 62 to col. 15 line 4); and

transmitting the message and alert indication to the user device (col. 27, claim 1 and col. 28, claim 7).

Referring to claim 14, Theimer et al. disclose a method of claim 13, further comprising the step of determining whether the recipient of the message subscribes to a database system (100) (i.e. UserAgent) which records the recipient's alert indication preferences (col. 10 lines 8-21; see Figures 2-3).

Referring to claim 15, Theimer et al. disclose a method of claim 13, further comprising the step of transforming the message prior to transmitting the message (col. 27 and 28, claims 1 and 7).

Referring to claim 16, Theimer et al. disclose a method of claim 13, further comprising the step of determining the context of the recipient prior to transmitting the message (col. 9 lines 42-65 and col. 27 and 28, claims 1 and 7).

Referring to claim 20, Theimer et al. disclose an apparatus for providing a dynamic alert indication to a user of a communication device (i.e. pager of user 60), the apparatus comprising:
storage unit (102) (i.e. user profile) containing information associated with the user of the communication device (col. 9 lines 54-59);
it's inherent that a processor within UserAgent (100) for processing a signal from a transmitter to determine an environment-appropriate mode of an alert indication based on at least a portion of the information contained in the storage unit and context provided by the environment that the user is in (col. 9 lines 60-65); and a signal receiving device for receiving signal, the signal receiving device having means for sending the alert indication to the user (col. 25 lines 57-67 and col. 4 lines 27-43).

Referring to claim 21, Thiemer et al. disclose the apparatus as cited in claim 20, wherein the storage unit is in the communication device (i.e. see Abstract) and it's inherent that a pager have a memory storage within.

Referring to claim 22, Thiemer et al. disclose the apparatus as cited in claim 20, wherein the storage unit is in a service provider infrastructure (col. 9 lines 49-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 9-10,12 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motohashi (US# 5,815,081) in view of Theimer et al. (US# 5,493,692).

Referring to claims 1,12 and 23, Motohashi discloses a method of providing a dynamic alert indication to a user of a signal receiving device, the method comprising the steps of (col. 1 lines 64-67; see Figure 1):

transmitting a signal from a signal transmitting device to a signal receiving device (col. 2 lines 36-44; see Figure 1);

processing the signal to determine at least one mode to be associated with an alert indication, wherein the processing step includes the step of accessing a look-up table containing information associated with a user of the signal receiving device to determine the at least one mode to be associated with the alert indication (col. 3 line 44 to col. 4 line 19; see Figures 1-4); and

receiving the signal from a signal transmitting device in the signal receiving

device, wherein the signal alerts the user of the signal receiving device via the alert indication that the signal has been received by the signal receiving device (col. 3 line 44 to col. 4 line 19; see Figures 1-4).

However, Motohashi did not explicitly disclose that evaluating context provided by the environment that the user is in and is an environment-appropriate mode.

In the same field of endeavor of paging system, Theimer et al. discloses the alerting mode that evaluating context provided by the environment that the user is in (col. 4 lines 7-43 and col. 9 lines 42-65) in order to obtain privacy on the receiving side.

One of ordinary skill in the art understands that alerting mode that evaluating context provided by the environment that the user is in of Theimer et al. is desirable in the paging system of Motohashi because Motohashi suggests a radio paging receiver has a function which is called a call condition indicating codes relating to the call condition indicating function (col. 2 lines 36-67) and Theimer et al. suggest a method for selectively delivering electronic messages to an identified user in a system of mobile and fixed devices, including multiple display devices and multiple users, where the identity and location of each device, display device and user may be known to the system, based on the context of the system and the environment of the identified user (col. 4 lines 27-33). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to include alert message to the receiver of Theimer et al. in the paging system of Motohashi with the motivation for doing so would allow the user with more privacy of receiving the message.

Referring to claim 2-4, Motohashi in view of Theimer et al. disclose the method as cited in claim 1, Motohashi discloses wherein the mode of the alert indication is at least one of audible (24) (i.e. loudspeaker for produce melody ring tone) and non-audible (23,25) (i.e. LED, vibrator) (col. 3 line 22 to col. 4 line 20; see Figures 1 and 3-4).

Referring to claim 5, Motohashi in view of Theimer et al. disclose the method as recited in claim 1, Motohashi discloses wherein the mode of the alert indication is suggested by a sender of the signal (col. 1 lines 51-52).

Referring to claim 6, Motohashi in view of Theimer et al. discloses the method as recited in claim 1, Motohashi discloses wherein the accessing step occurs within the signal receiving device (col. 3 lines 44-57).

Referring to claim 7, Motohashi in view of Theimer et al. discloses the method as recited in claim 1, Theimer et al. disclose further comprising the step of evaluating the signal to determine its relative importance based on content of the signal (col. 4 lines27-42)

Referring to claim 9, Motohashi in view of Theimer et al. discloses the method as recited in claim 1, Theimer et al. disclose wherein the environment that the user is in is a context service environment (col. 4 lines 7-43 and col. 9 lines 42-65).

Referring to claim 10, Motohashi in view of Theimer et al. discloses the method as recited in claim 1, Motohashi discloses wherein the signal receiving device comprises one of a cellular telephone, personal digital assistant, and a pager (i.e. radio paging receiver) (col. 2 lines 36-44).

Referring to claim 24, Motohashi in view of Theimer et al. discloses the method as recited in claim 23, Motohashi discloses wherein the preferred mode of alert indication comprises a non-audible (23,25) (i.e. LED, vibrator) mode of alert (col. 3 lines 23-42).

Referring to claim 25, Motohashi in view of Theimer et al. discloses the method as recited in claim 23, Theimer et al. disclose wherein the environment that the user is in is a context service environment (col. 4 lines 7-43 and col. 9 lines 42-65).

Referring to claim 26, Motohashi in view of Theimer et al. discloses the method as recited in claim 23, Motohashi discloses wherein the processing step determines that no mode of alert indication may be utilized by the signal receiving device while within the environment (col. 4 lines 44-57).

Referring to claim 27, Motohashi in view of Theimer et al. discloses the method as recited in claim 23, Motohashi discloses further comprising the step of blocking

transmissions to and from the signal receiving device wherein a blocking instruction is determined during the processing step (col. 4 lines 44-57).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications form the examiner should be directed to Scott Au whose telephone number is (571) 272-3063. The examiner can normally be reached on Mon-Fri, 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached at (571) 272-3068. The fax phone

numbers for the organization where this application or proceeding is assigned are (703)-872-9306.

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